

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 27-35 will have been submitted for consideration by the Examiner and claims 17-22 and 25 will have been amended for greater clarity. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Advisory Action provided.

However, Applicant has submitted a PTO-1449 Form in the present application attached to the Response filed on November 8, 2005. Thus, Applicant respectfully requests that the Examiner send a copy of the signed PTO-1449 Form to Applicant with the next Official Action in order to confirm consideration of the documents cited therein.

Turning to the merits of the action, the Examiner has rejected claims 17, 21, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over ROY et al. (U.S. Patent Publication No. 2002/0062366) in view of ITOH (U.S. Patent Publication No. 2001/0021037). The Examiner has rejected claims 18 and 22 under 35 U.S.C. § 103(a) as being unpatentable over ROY et al. and ITOH in view of KUMPH et al. (U.S. Patent No. 6,839,755). The Examiner has rejected claims 19-20 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over ROY et al. and ITOH in view of UHLER et al. (U.S. Patent Publication No. 2001/0021037).

As noted above, Applicant has submitted claims 27-32 for consideration by the Examiner and has amended claims 17-22 and 25. Applicant respectfully traverses the above rejection based on the pending claims 17-28 and will discuss the outstanding

rejection with respect to these claims in the present application as will be set forth hereinbelow. The amendments to the claims merely clarify the subject matter recited therein, but do not narrow the scope of the claims.

Applicant's claims 17-20, 27 and 28 generally relate to a scanner apparatus which scans image data and includes an interface configured to be connected to a terminal apparatus via a network. The scanner apparatus includes a controller which includes a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus. The controller also includes a response transmitter configured to transmit, to the terminal apparatus, a response to the search packet. The controller additionally includes a receiver configured to receive, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to search packet is transmitted to the terminal apparatus. The controller also includes a transmitter configured to transmit to the terminal apparatus the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Claims 21-24 recite related terminal apparatuses. Claim 25 recites a related system. Claim 26 recites a related method.

In direct contrast, ROY et al. relates to a system in which a HTTP client 15 sends an HTTP request to the management station 5, the management station 5 sends a DLP broadcast request to a plurality of SNMP agents 20, 25, 20. The management station 5 receives, from each of the plurality of the SNMP agents, a response to the DLP

broadcast request, and the management station 5 sends the HTML list of devices to the HTTP client 15.

However, ROY et al. does not disclose a scanner apparatus including a search packet receiver that receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, and response transmitter that transmits, to the terminal apparatus, a response to the search packet. In ROY et al., the Examiner appears to consider the HTTP client 15 to correspond to the terminal apparatus recited in, e.g., claim 17, and the SNMP Agent to correspond to the scanner apparatus recited in, e.g., claim 17. However, in ROY et al., the SNMP Agent receives, from the management station 5, the DLP broadcast request, but does not receive anything (and certainly not a search packet, as defined) from the HTTP client 15 which the Examiner considers to be the terminal apparatus. Further, in ROY et al., the DLP broadcast request contains a request for any devices listening that are not already a member of linked list to respond and contains the IP addresses of devices that have already responded, such that the devices with a DLP server running will know not to respond if their address appears in the list (paragraph [0027]). Thus, the DLP broadcast request is not a search packet utilized to search for a scanner apparatus connectable to the terminal apparatus as recited in the pending claims.

Similarly, in ROY et al., the SNMP Agent sends, to the management station 5, a response to the DLP broadcast request, but does not send anything (and certainly not a response as defined) to the HTTP client 15, as required by claim 17. Further, in ROY et al., the DLP response is a response to the DLP broadcast request. The DLP

response is also not a response to the search packet as recited in the pending claims, since the DLP broadcast is not a search packet utilized to search for a scanner apparatus connectable to the terminal apparatus, as discussed above.

Thus, Applicant submits that ROY et al. does not disclose the combination of features recited in the pending claims and claims 17-26 are thus clearly distinguished over ROY et al.

In setting forth the rejection, the Examiner admits that ROY et al. fails to disclose "receiving IP address from the terminal apparatus, and transmitting the scanned image to the terminal apparatus based on the scanned image data". The Examiner is incorrect. Applicant's claims do not recite the limitation noted by the Examiner. Rather, Applicant's claim recites, and ROY et al. fails to disclose, "transmitting the scanned image data to the terminal apparatus based on the IP address data".

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 17-26 are not disclosed in ROY et al. cited by the Examiner.

The Examiner relies upon ITOH to disclose these features that are admittedly missing from ROY et al. However, ITOH does not, in fact, disclose these features.

ITOH relates to a network scanner apparatus which produces an image data signal, inputs an IP address of a transmitting destination of the image data signal (Fig. 7 S2 or S3), and transmits the image data signal to the terminal having the input IP address (Fig. 7 S9).

However, ITOH does not disclose a scanner apparatus which includes a receiver that receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, and a transmitter that transmits, to

the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Rather, ITOH merely discloses a network scanner apparatus which directly inputs the IP address of the transmitting destination via the operation portion 1 of the network scanner apparatus (paragraph [0106]) and transmits the image data signal to the terminal based on the IP address input via the operation portion 1 of the network scanner apparatus (paragraph [0114]). In other words, ITOH does not teach a scanner apparatus which receives terminal information from the terminal apparatus, and transmits the scanned image data to the terminal apparatus, based on information included in the received terminal information. Rather, in ITOH, the IP address of the transmitting destination is input via the operation portion 1 of the network scanner apparatus, but is not received from the transmitting destination (i.e., terminal apparatus). Thus, Applicant submits that the pending claims are clearly distinguished over ITOH.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 17-26 are not disclosed in ITOH cited by the Examiner. Claims 17-26 are also submitted to be patentable over the Examiner's proposed combination, since neither of ROY et al. and ITOH, nor any proper combination thereof, disclose the combination of features recited in Applicant's claims 17-26.

Moreover, the Examiner has set forth no proper motivation for the combination of ROY et al. and ITOH. In this regard, the Examiner asserted that motivation for the proposed combination would be based on eliminating the use of a server. However, eliminating the use of a server in ROY et al. would render the entire system non-functional. In this regard, Applicant notes that the HTTP server of management station

5 is an essential component with respect to finding the desired network devices. In this regard, the Examiner's attention is respectfully directed to ROY et al., paragraph [0023].

Moreover, even if the proposed combination was motivated and serves the purpose of eliminating the server, the limitations and recitations of the present claims would not be disclosed thereby. In this regard, Applicant notes that ITOH does not receive search packets from the terminal with the search packets being utilized to search for a scanner apparatus connectable to the terminal apparatus, at least since the terminal apparatus identification is (manually) input by the operation portion 1 of ITOH. Thus, even if the proposed combination were properly motivated, it would not meet the terms of Applicant's claims.

Moreover, ITOH does not disclose the features that the Examiner has asserted that it discloses. In particular, paragraph [0106] does not disclose receiving terminal information from the terminal. Rather, this paragraph merely indicates that the terminal address is directly input using operation portion 1. Similarly, paragraph [0114] does not disclose transmitting the scanned image data to the terminal apparatus "based on the IP address of the terminal apparatus included in the received terminal information" at least since no terminal information is disclosed to be received in ITOH. Rather, paragraph [0114] discloses that the transmission portion 7 of the network scanning apparatus 100 utilizes the SMTP protocol obtained from the protocol control portion 8 (of the network scanner apparatus) using the IP address designated by the transmission requirement as a parameter. As noted previously, in ITOH the IP address is designated via the operation portion 1 rather than as recited in Applicant's claims.

Accordingly, ITOH does not disclose the features for which the Examiner relied thereupon.

For each of these reasons and certainly for all of these reasons, it is respectfully submitted that the Examiner's proposed rejection of any claims in the present application as unpatentable over any proper combination of ROY et al and ITOH is inappropriate. Thus, reconsideration and withdrawal thereof is respectfully requested in due course.

The Examiner's rejection of claims 18 and 22 under 35 U.S.C. § 103 as unpatentable over ROY et al. and ITOH and further in view of KUMPF et al. is also traversed.

KUMPF et al. relates to a network peripheral server discovery method for discovering peripheral servers that a peripheral specific software can utilize.

However, KUMPF et al. does not even supply the above-noted shortcomings of ROY et al. and ITOH. Further, KUMPF et al. also does not disclose a scanner apparatus which transmits, to the terminal apparatus, the response to the search packet, when the identification information of the search packet matches identification information of the scanner apparatus. Rather, in KUMPF et al., the client 12 displays a list of peripherals 16 attached to the servers 10, and a user at the client 12 selects a peripheral, e.g., a scanner (col. 4, lines 47-63). In other words, the scanner apparatus does not transmit, to the client 12, a response to a predetermined packet, but the scanner is merely selected by the user at the client, via the list of peripherals displayed on the client 12. Thus, claims 18 and 22 are clearly distinguished over KUMPF et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 18 and 22 are not disclosed in KUMPF et al. cited by the Examiner. Claims 18 and 22 are also submitted to be patentable over the Examiner's proposed combination, since neither of ROY et al., ITOH, and KUMPF et al., nor any proper combination thereof, disclose the combination of features recited in Applicant's claims 18 and 22.

The Examiner's rejection of claims 19, 20, 23 and 24 under 35 U.S.C. § 103 as unpatentable over ROY et al. and ITOH in view of UHLER et al. is further traversed.

UHLER et al. relates to a method and apparatus for accessing a scanner on a network using HTTP. The client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner, and the HTTP Scanner Server determines whether the request is valid.

However, UHLER et al. does not disclose terminal information which the scanner apparatus receives from the terminal apparatus and includes an IP address of the terminal apparatus, since UHLER et al. merely discloses that the client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner and since UHLER et al. does not contain any disclosure about the recited terminal information. Thus, again UHLER et al. cannot overcome the shortcomings of KUMPF et al. Thus, pending claims 19-20 and 23-24 are clearly distinguished over UHLER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 19-20 and 23-24 are not disclosed in UHLER et al. cited by the Examiner. Thus, pending claims are also submitted to be patentable over the Examiner's

proposed combination, since even combination of ROY et al., ITOH and UHLER et al. does not disclose the combination of the features recited in Applicant's claims 19-20 and 23-24.

In setting forth the rejection based upon UHLER et al., the Examiner relies on paragraph [0062] of UHLER et al. for motivation. However, this paragraph does not even contain the motivation asserted by the Examiner. This paragraph deals with an authentication server 206 and does not support the Examiner's assertion with respect to motivation.

Similarly, with respect to the Examiner's asserted motivation for the combination of features of KUMPF et al. with ROY et al. and ITOH, the Examiner relies upon column 4, lines 35-46. However, this portion of the KUMPF et al. disclosure merely indicates that after removing inappropriate servers from the data list, each remaining server is checked to determine that it contains the required firmware by sending an SNMP query. Accordingly, even the Examiner's basis for motivation does not support the combination of KUMPF et al. with the features of ITOH and ROY et al.

Regarding the motivation for the combination of ROY et al. and ITOH, the Examiner relies upon paragraph [0015] of ITOH. However, this paragraph merely describes the advantages of ITOH over the prior art and does not relate to any motivation or advantage of combining the teachings of ITOH with ROY et al.

Accordingly, none of the bases for motivation relied upon by the Examiner are adequate or sufficient to support the Examiner's position. Accordingly, each of the Examiner's rejections is inappropriate and each of Applicant's claims are clearly patentable over the prior art of record in the present application.

Further, Applicant respectfully notes that the Examiner discusses TOYODA (U.S. Patent No. 6,88,019) in the Advisory Action mailed on December 29, 2005. However, this document was not utilized in any outstanding rejection in the present application. Furthermore, TOYODA is not qualified as a prior art under 35 U.S.C. § 103(c). The filing date of the present application is January 29, 2002. TOYODA was filed in the United States on March 10, 2000, and the patent was issued on April 12, 2005. Thus, TOYODA can qualify as a prior art only under 35 U.S.C. § 102(e). However, both the present application and TOYODA were subject to an obligation of assignment to the same person (Panasonic Communications Co., Ltd) at the time the present invention was made. Thus, TOYODA is not a prior art under 35 U.S.C. § 103(c).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and requests an indication of the allowability of all the claims pending in the present application, in due course.

In the Advisory Action dated December 29, 2005, the Examiner discussed the ROY et al. reference relied upon. In discussing the reference, the Examiner noted that management station sends an HTTP request and in turn sends a DLP broadcast request. In this regard, the Examiner is correct. However, this feature, rather than supporting the Examiner's position, undermines it and emphasizes the distinctions between the present claimed invention and the ROY et al. system. In ROY et al, it is the management station 5, not the terminal (considered by the Examiner to read on HTTP Client 15) that sends the request. While, as the Examiner points out, the management station sends a list of devices, this does not comply with the requirement for response as recited in, e.g., Applicant's claim 17. Therein, Applicant recites and

requires that the scanner transmit to the terminal apparatus a response to the search packet. In ROY et al., and as admitted by the Examiner, it is the management station that is sending the list of devices rather than the scanner. The lack of this significant feature of Applicant's invention is a yet additional basis for the patentability of the claims pending in the present application.

The Examiner points out, in the Advisory Action, that KUMFP and ROY et al. disclose the process of searching for a scanner apparatus. While this may or may not be true, and the Applicant makes no admission in this regard, it is quite clear that the combination of features recited in Applicant's claims are not taught, disclosed nor rendered obvious by ROY et al. or any proper combination of ROY et al. and ITOH at least for the reasons set forth above.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has submitted new claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Yutaka IYOKI

William Pieprz
Reg. No. 33,630



Bruce H. Bernstein
Reg. No. 29,027

January 24, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191